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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,519	01/08/2004	Randall Lane Grimm	ROC920030317US1	9852
46296 7590 03/09/2009 MARTIN & ASSOCIATES, LLC P.O. BOX 548 CARTHAGE, MO 64836-0548				
EXAMINER				
CARDENAS NAVIA, JAIME F				
ART UNIT		PAPER NUMBER		
3624				
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03/09/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/753,519

Applicant(s)

GRIMM ET AL.

Examiner

Jaime Cardenas-Navia

Art Unit

3624

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-12 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-12 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Introduction

1. This **NON-FINAL** office action is in response to communications received on January 16, 2009. Claims 7, 8, 10, and 11 have been amended. Claim 23 has been added. Claims 7-12 and 23 are currently pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 16, 2009 has been entered.

Response to Amendment

3. **New grounds of rejection under 35 U.S.C. § 101** are presented below.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 7-12 and 23 are rejected** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent (See *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978)) and recent Federal Circuit decisions (See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (2008)), a method claim must have a specialized, limited meaning to qualify as a patent-eligible process claim. This is embodied in the "machine or transformation test", which states that a § 101 process must (1) be tied to a particular machine or apparatus or (2) transform a particular article to a different state or thing.

More specifically, the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Thus, a field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. Additionally, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. Thus, reciting a specific machine or a particular transformation in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

Independent claims 7, 11, and 23 contain steps that are not necessarily tied to a particular machine or apparatus and are therefore directed to non-statutory subject matter. Examiner notes that for process claims implemented on a computer to be considered statutory, they must make clear which steps are executed on the computer and which steps are executed manually.

Examiner does not believe it has been made sufficiently clear that the steps are performed on a computer, rather than merely implemented with the aid of a computer. For purposes of examination, Examiner has assumed that necessary corrections have been made.

Response to Arguments

6. Applicant's arguments have been fully considered by the Examiner. In particular, Applicant argues regarding independent claims 7 and 11 that (1) Wyman does not teach or suggest determining whether unused billed capacity *assigned to a second resource* of the same type as the first resource is available. Additionally, Applicant argues that (2) all dependent claims are allowable as a result.

Regarding argument (1), Examiner respectfully disagrees. In one embodiment, Wyman teaches transitive licensing, in which one user requests and may be granted permission to use a resource currently allocated to another user (col. 7, lines 36-53, "mechanism for one user node to get permission to use another software product located on another user node"). Thus, Wyman teaches determining whether unused billed capacity (software license usage right) assigned to a second resource (software product, running on a second node) of the same type as the first resource is available (calling authorization).

Regarding argument (2), Examiner respectfully disagrees as per the response to argument (1) above.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 7-12 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Wyman (US 5,745,879) in view of Donovan et al. (US 6,012,032).

Regarding claim 7, Wyman teaches a computer-implemented method for providing metered accounting of at least one resource on demand (Abstract), the method comprising the steps of:

determining when a first resource is required (col. 6, lines 24-38);

when the first resource is required (col. 6, lines 24-38), determining whether unused billed capacity assigned to a second resource of the same type as the first resource is available (col. 10, lines 8-19, col. 14, lines 20-42, units are unused billed capacity for the same type of resource, col. 7, lines 36-53, "mechanism for one user node to get permission to use another software product located on another user node"); and

when unused billed capacity assigned to the second resource is available, assigning the unused billed capacity assigned to the second resource to the first resource (col. 10, lines 8-19, col. 14, lines 20-42, units are unused billed capacity for the same type of resource, col. 7, lines 36-53, "mechanism for one user node to get permission to use another software product located on another user node").

Wyman does not teach wherein the resources are hardware resources.

Donovan teaches providing metered capacity of at least one hardware resource (col. 1, lines 58-67).

The inventions of Wyman and Donovan pertain to providing metered capacity of resources. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective

functions, as Donovan does not teach away from or contradict Wyman, but rather, teaches a function that was not addressed. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention as the algorithms used for monitoring resources work independently of what the actual resource is. Thus, it would have been obvious to combine the teachings, motivated by the need to monitor hardware resources rather than software resources.

Regarding claim 8, Wyman teaches billing a predetermined resource-time for the first resource if no unused paid capacity assigned to the second resource is available (col. 14, lines 31-42, if there are no more units available, then the license holder is required to pay for the additional use, col. 7, lines 36-53, "mechanism for one user node to get permission to use another software product located on another user node").

Wyman does not teach wherein the selected resource is a hardware resource.

Donovan teaches providing metered capacity of at least one hardware resource (col. 1, lines 58-67).

The inventions of Wyman and Donovan pertain to providing metered capacity of resources. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, as Donovan does not teach away from or contradict Wyman, but rather, teaches a function that was not addressed. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention as the algorithms used for monitoring resources work

independently of what the actual resource is. Thus, it would have been obvious to combine the teachings, motivated by the need to monitor hardware resources rather than software resources.

Regarding claim 9, Wyman teaches deducting the billed predetermined resource-time from a prepaid amount (col. 14, lines 20-42, units are a prepaid amount, the billed predetermined resource-time is deducted from this).

Regarding claim 10, Wyman teaches determining whether the first resource has already been billed (col. 12, lines 45-49, col. 14, lines 30-42, units, which have already been billed, are tracked, and accounting for all resource use is tracked and managed by the license manager for billing purposes).

Wyman does not teach wherein the selected resource is a hardware resource.

Donovan teaches providing metered capacity of at least one hardware resource (col. 1, lines 58-67).

The inventions of Wyman and Donovan pertain to providing metered capacity of resources. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, as Donovan does not teach away from or contradict Wyman, but rather, teaches a function that was not addressed. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention as the algorithms used for monitoring resources work independently of what the actual resource is. Thus, it would have been obvious to combine the teachings, motivated by the need to monitor hardware resources rather than software resources.

Regarding claim 11, Wyman teaches a computer-implemented method for providing metered capacity of at least one resource on demand (Abstract), the method comprising the steps of:

determining when a first resource is required (col. 6, lines 24-38);

determining whether the first resource has already been billed (col. 12, lines 45-49, col. 14, lines 30-42, units, which have already been billed, are tracked, and accounting for all resource use is tracked and managed by the license manager for billing purposes);

when the first resource has not already been billed, determining whether unused billed capacity assigned to a second resource of the same type as the first resource is available (col. 10, lines 8-19, col. 14, lines 20-42, units are unused billed capacity for the same type of resource, col. 7, lines 36-53, "mechanism for one user node to get permission to use another software product located on another user node");

when unused billed capacity assigned to the second resource is available, assigning the unused billed capacity assigned to the second resource to the first resource (col. 10, lines 8-19, col. 14, lines 20-42, units are unused billed capacity for the same type of resource, col. 7, lines 36-53, "mechanism for one user node to get permission to use another software product located on another user node"); and

when unused billed capacity assigned to the second resource is not available, billing a predetermined resource-time for the first resource (col. 14, lines 31-42, if there are no more units available, then the license holder is required to pay for the additional use, col. 7, lines 36-53, "mechanism for one user node to get permission to use another software product located on another user node").

Wyman does not teach wherein the resources are hardware resources.

Donovan teaches providing metered capacity of at least one hardware resource (col. 1, lines 58-67).

The inventions of Wyman and Donovan pertain to providing metered capacity of resources. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, as Donovan does not teach away from or contradict Wyman, but rather, teaches a function that was not addressed. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention as the algorithms used for monitoring resources work independently of what the actual resource is. Thus, it would have been obvious to combine the teachings, motivated by the need to monitor hardware resources rather than software resources.

Regarding claim 12, Wyman teaches deducting the billed predetermined resource-time from a prepaid amount (col. 14, lines 20-42, units are a prepaid amount, the billed predetermined resource-time is deducted from this).

9. **Claim 23 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Eng (US 2002/0169725 A1).

Regarding claim 23, Eng teaches a computer-implemented method for providing metered capacity of a plurality of processors on demand in a computer system, the method comprising the steps of:

(A) determining total resource usage of the plurality of resources in the computer system across a plurality of logical partitions (par. 11, "realtime determination of a number of software licenses allocated to software users at a plurality of nodes", par. 12);

(B) determining base resource usage of the plurality of resources in the computer system across a plurality of logical partitions (par. 12, 61, license allocation condition is when usage exceeds capacity);

(C) when the total resource usage determined in step (A) exceeds the base resource usage determined in step (B) (par. 12, 61, license allocation condition is met), performing the steps of:

 expiring all timed-out usage windows for all of the plurality of resources (par. 11, 12, 60, identifying and deallocating resources to failed nodes);

 selecting one of the plurality of resources (par. 60);

 when the selected resource is unbilled, determining whether there is unused billed capacity assigned to one of the other of the plurality of resources (par. 60, identifying and freeing up resources not in use);

 when there is unused billed capacity assigned to one of the other of the plurality of resources, assigned the unused billed capacity assigned to the one of the other of the plurality of resources to the selected resource (par. 60, identifying and freeing up resources not in use); and

 when there is no unbilled capacity assigned to any of the other of the plurality of resources, billing a predetermined resource-time for the selected resource (par. 66, grace period allows administrator to purchase additional resources).

Eng does not explicitly teach wherein the resource is a processor.

Official notice is given that monitoring and managing processor usage was old and well-known to one of ordinary skill in the art at the time of the invention.

All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention as the algorithms used for monitoring resources work independently of what the actual resource is. Thus, it would have been obvious to combine the teachings, motivated by the need to monitor processor resources rather than software resources.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Wiggins (US 5,717,604) teaches a system and method for detecting and freeing up resources whose users are inactive as well as realtime billing, resource pooling, and managing resources by priority.

Read (US 2005/0049973 A1) teaches an automatic software application for detecting fallow resource use, notifying the user, and providing options for ultimately freeing up the resources.

Abrams (US 2002/0166117 A1) teaches managing metered resource use.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaime Cardenas-Navia whose telephone number is (571)270-1525. The examiner can normally be reached on Mon-Fri, 10:30AM - 7:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Bayat can be reached on (571) 272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

March 3, 2009

/J. C./
Examiner, Art Unit 3624

/Bradley B Bayat/
Supervisory Patent Examiner, Art Unit 3624